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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,980

08/29/2006

Juergen Roeder

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EXAMINER

HINES, LATOSHA D

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,980	Applicant(s) ROEDER, JUERGEN	
	Examiner LATOSHA HINES	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/29/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the initial Office action based on the 10/590980 application filed on August 29, 2006.
2. Claims 1-16 are pending and have been fully considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over BONGART et al. (WO 02/38707).

With respect to claims 1-16 BONGART et al. discloses a fuel composition which is substantially free of alkoxyated compounds, contains at least 95% by volume of a **hydrocarbon-based fuel** and 0.1 to 5% by volume of an additive (page 2 lines 6-9). The hydrocarbon-based fuel, which includes an amount of a oxygenator, for example alcohol or alcohols. Such alcohols are preferentially C1 to C6 **alkanols**, such as propanol, butanol, or ethanol, and isomers thereof. The most preferred alcohol is **ethanol**. In such a composition the alcohol may be present in an amount of from 1 to 10% by volume of the composition (page 3 lines 14-19). Preferably, the fuels contain diesel oil or consist of **diesel oil**. They also include the so-called **bio-diesel**, i.e. a **fatty acid methyl ester**, preferably the methyl ester of **rape seed oil fatty acid** (page 2 lines 19-30). The fuel

composition comprises a water soluble alcohol, a C6 to C12 alcohol, a C6 to C18 ethoxylated alcohol, a C10 to C24 fatty acid, and a nitrogen source. According to a first aspect of the present invention we provide a fuel composition which is substantially free of alkoxyated compounds and is substantially free of long-chain alkyl alcohols having at least 6 C atoms, and contain at least 95 % by volume of a hydrocarbon-based fuel and 0.1 to 5 % by volume of an additive of the 10 formula (I):



in which R is a saturated or unsaturated, linear or branched alkyl radical having 6 to 21 C atoms; and R1 and R2, which may be the same or different, each represent a hydroxyalkyl radical having 1 to 4 C atoms (page 2 lines 6-17). The nitrogen compound may be selected from the group consisting of ammonia, mono-alkyl ethanolamine, and **di-alkyl ethanolamine** (di-alkanolamines). The nitrogen compound may be an anhydrous compound or a hydrous compound and may be up to a **5% w/w aqueous solution** (page 6 lines 4-22). The fuel compositions are prepared by mixing the fuel additive with a fuel/ethanol mixture. TODD et al. discloses the claimed invention except for explicitly stating reaction of di- or trialkanolamines with vegetable oils or with alkyl esters of the fatty acid mixtures from vegetable oils. It would have been obvious to one having ordinary skill in the art at the time the invention was made to state the compound was formed from reacting a fatty acid ester with a di- or trialkanolamine since it was

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known in the art that this formation produces a additive and TODD teaches that the additive of formula (I) may be oleic acid diethanolamide , which is may be the reaction product of an oleate and diethanolamine. Preferred fuel compositions are those in which the volume ratio of fuel, for example petroleum diesel to additive is in the range of **1000:0.5 to 1000:50** and preferably of **1000:1 to 1000:50** (page 3 lines 21-24). Regarding composition claims, if the composition is physically the same, the composition must have the same properties (see MPEP § 2112). The Courts have held that it is well settled that where there is a reason to believe that a functional characteristic would be inherent in the prior art, the burden of proof then shifts to the applicant to provide objective evidence to the contrary. See *In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1478, 44 USPQ2d at 1432 (Fed. Cir.1997). “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See *In re Aller*, 220 F2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (see MPEP § 2144). BONGART et al. discloses 2 trial examples of the effects of the additives to the fuel composition. In Trial Example 1 the effect of the additives was tested by the cold filter plugging point test (CFPP). The additive-containing fuel was cooled stepwise to 30°C, in each case a sample was taken at 1°C temperature intervals and being sucked through a standardized **filter** means at reduced pressure of 2 kPa (page 9 lines 20-29). The discovery of an optimum value of a known result effective variable, without producing any new or unexpected results, is within the ambit of a person of

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ordinary skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The reference RAE (US 2003/0163952) discloses a fuel composition comprising bio-diesel and a surfactant, characterized in that the surfactant comprises a mixture of an alkanolamide, an alkoxyated alcohol and an alkoxyated fatty acid or a derivative thereof (abstract).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATOSHA HINES whose telephone number is 571-270-5551. The examiner can normally be reached on Monday thru Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LATOSHA HINES/
Examiner, Art Unit 1797

//Cephia D. Toomer//

Primary Examiner, Art Unit 1797